

REMARKS

In response to the Notice of Non-Compliant Amendment mailed April 8, 2008 and restriction requirement mailed February 11, 2008, Applicants provisionally elect with traverse Species I, Figures 1-5 and 7. This species is directed to at least claims 1-3, 5, 6, 7, 9-11. As stated below, the Examiner has not provided a *prima facie* basis for restriction of Figure 6, and Applicants respectfully request that Figure 6 be included within the elected species.

It will be recalled that the statutory basis for restriction requirements refers to **claims**, not drawing figures. 35 U.S.C. §121 states that “If two or more independent and distinct inventions are **claimed** in one application, the Director may require the application to be restricted to one of the inventions.” (Emphasis added) Consistent with this requirement, the Manual of Patent Examining Procedures (M.P.E.P.) instructs Examiners to base a restriction on the **claims**. Some excerpts from Chapter 800 of the M.P.E.P., which governs restriction practice, are the following:

In passing upon questions of double patenting and restriction, it is the **claimed** subject matter that is considered and such **claimed** subject matter must be compared in order to determine the question of distinctness and independence. M.P.E.P. § 806.01. (Emphasis added).

Where the **claims** of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. M.P.E.P. § 806.03 (Para. 1). (Emphasis added).

Where an applicant files a divisional application claiming a species previously **claimed** but nonelected in the parent case . . . there should be no determination of whether or not the species **claimed** in the divisional application is patentable over the species retained in the parent case since such a determination was made before the requirement to restrict was made. M.P.E.P. § 806.04(h) (Para.1). (Emphasis added).

[T]he Examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she would be

prepared to allow **claims** to each of the **claimed** species over the parent case, if presented in a divisional application. M.P.E.P. § 806.04(h) (Para. 2).

The form Outline of Letter for Restriction requires the Examiner to, “List **claims** in each group.” M.P.E.P. § 817 Outline of Letter (a)(2).

In addition, under M.P.E.P. § 808, every restriction requirement has two requirements which must be presented by the Examiner to provide a prima facie case for a proper restriction requirement. These are (a) reasons, as distinguished from the mere statement of conclusions, must be provided by the Examiner as to why each invention as claimed is either independent or distinct from the other; and (b) the reasons must be provided as to why there would be a serious burden on the Examiner if the restriction is not required.

In addition to this requirement, M.P.E.P. § 808.01 states in applications where generic claims are presented, restriction cannot be required unless a generic claim covers such a multiplicity of species that an unduly extensive and burdensome search would be necessary to search the entire scope of the claim. Therefore, the Examiner must show one of the following: that there is a separate classification between the distinct inventions; that a separate status in the art is applied to each invention even though they may be classified together; or that it is necessary to search different fields of art for the distinct inventions.

In the present case, the Examiner has not provided any statements or provided any arguments as to how the embodiments in the figures are distinct from one another. In addition, the Examiner has not provided any reasons as to why there would be an excessive burden to search the additional subject matter in Figs. 6 and 8-17 whereas Figures 1-5 and 7 are lumped together as a species and thus not apparently an excessive burden for the Examiner. In particular, the Examiner has provided no arguments to establish that searching for divergent flow guide grooves in Figure 6

would be burdensome and would require searches in other fields. Additionally, the Examiner has not provided any arguments why fluid supply ports on the top surface or fluid reservoir in the body would be burdensome and would require searches in other fields. Further, the Examiner has not shown why searching for a plurality of holders would be burdensome and would require searches in other fields. Accordingly, the Examiner has not satisfied a *prima facie* case of showing that a restriction requirement is warranted. For at least these reasons, the restriction requirement is improper and should be withdrawn.

The Applicant also traverses the Restriction Requirement on the basis that the identification of species based upon figures unduly limits the scope of protection of any of the elected species. Should any of the current claims, or any claims added later in prosecution, be deemed by the Patent Office or a court to be read under 35 U.S.C. 112, paragraph 6, then those claims would be potentially limited to the embodiment shown in the elected figures. Therefore, election of a species based on a figure or figures, where all other species are also identified by a figure or figures, has the effect of "removing" from the specification all figures not identified as being a part of the elected species. In the present case, under the current Restriction Requirement, if the Applicant were to elect a figure, the embodiments in the non-elected figures would be effectively removed from the scope of the claims. For at least these reasons, the Applicant respectfully submits that the current Restriction Requirement is improper and be withdrawn.

Should the Examiner elect to maintain the present Restriction Requirement or otherwise reject this application finally or non-finally for the Applicant's refusal to elect a figure for prosecution, then this paper is to be treated as a petition to the Director under 37 C.F.R. §1.183 to waive such rules as necessary, in the interests of justice, to prevent an unnecessary extinguishment of the Applicant's rights as detailed above. Any fees associated with the petition may be charged

to our deposit account as set forth below. The Applicant reserves the right to pursue the claims of any other species in a divisional application.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account 50-1698.

Respectfully submitted,

Dated: May 7, 2008

/Suvashis Bhattacharya/
Suvashis Bhattacharya
Reg. No. 46,554

THELEN REID BROWN RAYSMAN & STEINER LLP
PO Box 640640
San Jose, CA 95164-0640
Telephone: (408) 292-5800
Facsimile:(408) 287-8040